



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,106	04/13/2001	Dan A. Steinberg	ACT.008	4209

7590 05/20/2002

JONES VOLENTINE, L.L.C.
Suite 150
12200 Sunrise Valley Drive
Reston, VA 20191

EXAMINER

ZARROLI, MICHAEL C

ART UNIT	PAPER NUMBER
----------	--------------

2839

DATE MAILED: 05/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/835,106

Applicant(s)

STEINBERG ET AL.

Examiner

Michael C. Zarroli

Art Unit

2839

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-26 and 28-33 is/are allowed.
- 6) ☒ Claim(s) 1,2,6 and 34 is/are rejected.
- 7) ☒ Claim(s) 3-5,7-17 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other:

DETAILED ACTION

Claim Objections

1. Claim 34 is objected to because of the following informalities: In line 3, "wavguide" is misspelled. Appropriate correction is required.
2. Claim 27 objected to because of the following informality: In the last line, shouldn't "to at least" read --from at least--? Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 6 and, 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation "said transverse movement" in line 1. There is insufficient antecedent basis for this limitation in the claim.

The last phrase of claim 34 is confusing. Are there at least three grooves and opposing depressions, on the substrate or the entire switch? Should this last

phrase be a separate paragraph? Are the “no two opposing depressions” on the same surface or between the substrate and waveguide holder? If you have one waveguide, then you’ll have two depressions and, the substrate will have two depressions. Therefore you have a total of four depressions. Three of these four are grooves, then there’s no possibility of “opposing depressions” being pits.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaplow et al (US 5440655).

Kaplow discloses an optical switch (col. 1 lines 6-9) with first and second waveguide holding members (37, 38) with the second holder disposed over a substrate (fig. 4A). The first waveguide holder moves relative to the second by the movement of a guiding member, which guides the motion of the first waveguide holder (figures 6-7).

Regarding claim 2 Kaplow discloses the second waveguide holding member stationary relative to the substrate (fig. 4A).

Allowable Subject Matter

7. Claims 18-33 are allowed over the prior art of record.
8. Claims 3-5 and, 7-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. Claim 34 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.
10. Claim 6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
11. The following is a statement of reasons for the indication of allowable subject matter: A substrate with two waveguide holders disposed thereon. Various combinations and orientations of pits and grooves between these holders and the substrate. Positioning members in these pits and grooves aid the positioning of the holders in order to accomplish an optical connection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Blonder teaches a substrate with grooves and, pits but no waveguide holding members.

Pimpinella teaches waveguide holders with pits, grooves and positioning members but no substrate with pits and grooves in various configurations.

Yokomachi et al teaches waveguide holders with grooves but no substrate or any pits.

Presby teaches waveguide holders with grooves but no pits and none of the grooves are in various configurations.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Zarroli whose telephone number is 703-305-0608. The examiner can normally be reached on 7:30 to 3:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be reached on 703-308-3119. The fax

Application/Control Number: 09/835,106
Art Unit: 2839

Page 6

phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



Michael C. Zarroli
Examiner
Art Unit 2839

MCZ

MCZ
May 10, 2002